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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,172	03/19/2002	Masatoshi Kobayashi	112044	7545

7590

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Oliff & Berridge  
PO Box 19928  
Alexandria, VA 22320

EXAMINER

BROCKETTI, JULIE K

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/069,172

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Julie K Brockett

**Art Unit**

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 24-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

37 CFR 1.75(c) states:

**(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.** Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

Claims 24-28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. At first glance claims 24-28 appear to be dependent claims since they reference another claim in the limitations. However, the claims are directed towards a separate invention, i.e. a game system. Therefore, they do not further limit the subject matter of a previous claim. For example, in claim 24, the limitations of claim 1 are merely being incorporated into a game system (through a short-hand method by referencing claim 1) and it is the game system that is being further limited by the additional claim language, not the

device of claim 1. Consequently, claim 1 is not being further limited by the limitations of claim 24. While the short-hand way of writing the claim is acceptable. The claim is independent and the necessary fees associated with independent claims must be paid. See MPEP 608.01(n) which states: "Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.) The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee."

### ***Allowable Subject Matter***

Claims 1-23 are allowed over the prior art of record.

Claims 24-28 would be allowed if re-written in proper independent form.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record lacks in disclosing a cut-out portion in

a connection portion between parts of the light-proof member in order to form a through-hole for a signal terminal of the optical sensor. The prior art also lacks in disclosing a second light-proof member to prevent the incidence of the external light from a gap between the board and a slit provided in the light-proof member for the insertion of the board. Furthermore as pointed out in Applicant's arguments, the closest prior art of record, Fujimoto, does not disclose a light-proof member that is provided in the indicator body and covers the lens and the optical sensor completely in such a manner that external light other than light from the light-incident aperture is not incident on the lens and the optical sensor. Fujimoto provides a filter that allows infrared light through it. Therefore, the filter is not a light-proof member that completely covers the lens and optical sensor so that external light is not incident on these elements.

#### ***Response to Amendment***

It has been noted that claims 24-28 have been amended.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Response to Arguments***

Applicant's arguments, filed November 23, 2004, with respect to the finality of the rejection mailed on August 23, 2004 has been fully considered

and is persuasive. The finality of the office action mailed on August 23, 2004 has been withdrawn.

Applicant argues that claims 24-28 are in proper dependent form since claims 24-28 properly include all of the features recited in the base claims and include additional features. Applicant points out that MPEP § 608.01(n) states that "the fact that a dependent claim which is otherwise proper might relate to a separate invention...would not render it an improper dependent claim. While the Examiner notes that both of these allegations may be true. The main test for determining whether or not a dependent claim is in proper dependent form is whether or not it further limits the subject matter of the independent claim as stated in rule 37 CFR 1.75(c). Applicant's claims 24-28 do not further limit the subject matter of claims 1, 5, 12, 22 and 23. Applicant is merely incorporating the features of the independent claim into a separate system and is not further limiting them. Consequently, Applicant must re-write the claims in proper independent form and pay the associated fees.

Based on Applicant's amendments to claims 24-28, the 35 U.S.C. 112 enablement rejections have been withdrawn.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett  
Examiner  
Art Unit 3713